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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,929	04/19/2001	William J. Walker	500007-A-01-US (Walker)	8223
2292	7590	01/03/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,929

Applicant(s)

WALKER, WILLIAM J.

Examiner

J. Derek Rutten

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Acknowledgement is made of Applicant's Request for Continued Examination (RCE) dated 19 November 2004 responding to the 19 May 2004 Office Action provided in the rejection of claims 1-13, wherein claims 1-8 and 11-13 have been amended, no claims have been canceled, and no new claims have been added. Claims 1-13 remain pending in the application and have been fully considered by the examiner.
2. Applicant has primarily argued on page 9 of the amendment dated 10 September 2004 that the claims are not anticipated by the McLaughlin references because it was invented prior to the publication of those references, as evidenced by the Declaration under 37 CFR 1.131 and entered with the RCE on 19 November 2004. This argument is not persuasive; as will be addressed under the *Declaration* section below.

Declaration

3. The declaration filed on 19 November 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the McLaughlin-3 or McLaughlin-4 references.

Applicant is attempting to establish prior invention by conception prior to January 26, 2000 coupled with diligence from September 2000 (date of *McLaughlin-3* reference) to April 19, 2001 (date of filing).

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. Any exhibit relied upon to provide such evidence should be specifically referred to in the declaration, **in terms of what it is relied upon**

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to show. A general allegation that the invention was completed prior to January 26 2000 is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to September 2000 (*McLaughlin-3*), without a statement of **facts demonstrating the correctness** of this conclusion, is insufficient to satisfy 37 CFR 1.131. An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989). The declaration must **clearly explain which facts or data applicant is relying on** to show completion of his or her invention prior to September 2000. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out **exactly what facts are established and relied on** by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

In order to show prior invention, the showing of facts must be sufficient to show:

(A) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

The declaration filed on 19 November 2004 merely asserts that conception existed prior to January 26, 2000. Several documents are provided in an attempt to support this date of conception. However, the declaration does not meet the requirements for providing exhibits since it does not specifically refer to each exhibit **in terms of what it is relied upon to show**, nor does it clearly explain which facts or data applicant is relying upon to show conception of the invention prior to January 26 2000 coupled with due diligence from September 2000 (*McLaughlin-3*) to April 19 2001 (date of filing). If supported by an appropriate declaration or affidavit, the seven page document entitled "A Mechanism for Converting Between Java Classes and XML" would appear to be sufficient to show conception. However, conception of the invention has not been sufficiently shown, and thus the declaration is ineffective to overcome the *McLaughlin-3* and *McLaughlin-4* references.

In the interest of compact prosecution, it is noted that due diligence has not been particularly pointed out, especially from the period from September 2000 (*McLaughlin-3*) to April 19 2001 (date of filing). This observation is merely exemplary and is not comprehensive. In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). See MPEP 715.07(a). However, once prior conception is established, due diligence must be demonstrated. Under 37 CFR 1.131, the critical period in

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which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Applicant's declaration does not cite any exhibits showing diligence from September 2000 through April 19 2001.

Response to Amendment

4. Applicant's amendments submitted 10 September 2004 have been previously entered. Therefore, the claim objections and rejections under 35 USC § 112 2nd have been withdrawn.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims rejected under 35 U.S.C. 102(a) as being anticipated by prior art of record "Data Binding from XML to Java, Part 3" by McLaughlin, published September 2000 (hereinafter referred to as "McLaughlin-3").

McLaughlin-3 discloses:

instantiating an object of a desired object-oriented programming language class

(See page 3 paragraph 2: "Once a new instance of the appropriate class is created...");

in the case of said instantiated object, implementing a predefined interface (See page 3 paragraph 2: “Once a new instance of the appropriate class is created, the mutator methods are called with the values supplied in the XML document.” The mutator methods are part of a predefined interface for setting attribute values. Listing 3 on page 3 shows the corresponding implementation of a mutator method. Mutator methods are commonly used for setting attribute values.),

iteratively processing each object included within said instantiated object (See page 4 paragraph 4: “Once all the attributes are read and assigned to the created Java instance, you need to take each nested element and perform the unmarshalling again.”)

according to the steps of:

retrieving field descriptors associated with said object being processed (See page 4 paragraph 3: “Finally, the nested objects are passed to **accessor methods**, and the top-level object, which is populated with both member variable values and object **references**, is **returned** to the calling program.” Accessor methods are commonly used to retrieve attribute values including field descriptors.);

creating an object of a specified desired object-oriented programming language type for each XML element corresponding to a field descriptor (See McLaughlin-3 page 3 paragraph 2: “Once a new instance of the appropriate class is created, the mutator methods are called with the values supplied in the XML document.”; also page 4 paragraph 4: “Once all the attributes are read and assigned to the created Java instance, you need to take each nested element and perform the unmarshalling again.”); *and*

storing the created object in the currently processed object (See page 4 paragraph

4: "Once all the attributes are read and assigned to the created Java instance...").

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art of record "Data Binding from XML to Java, Part 4" by McLaughlin published on October 1, 2000 (hereinafter referred to as "McLaughlin-4") in view of McLaughlin-3.

The text of the rejections of claims 1 and 3-9 can be found in the previous Office action filed 19 May 2004.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin-4 in view of McLaughlin-3 as applied to claim 8 above, and further in view of "Data Binding from XML to Java Code, Part2" by McLaughlin published in August 2000 (hereinafter referred to as "McLaughlin-2").

The text of the rejection of claim 10 can be found in the previous Office action filed 19 May 2004.

10. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin-4 in view of McLaughlin-3 further in view of U.S. Patent 5,367,685 to Gosling (hereinafter referred to as "Gosling").

The text of the rejections of claims 11-13 can be found in the previous Office action filed 19 May 2004.

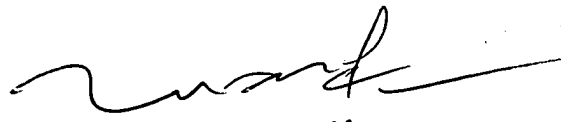
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The examiner can normally be reached on M, T, Th, F 6:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr


TUAN DAM
SUPERVISORY PATENT EXAMINER